

rejected under 35 U.S.C. § 103(a) as being unpatentable over Katzenmaier in view of Ferrari; claims 13 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Katzenmaier in view of Ferrari; claims 17-18 and 33-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Katzenmaier; and claims 11 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Katzenmaier in view of Gadsby. Applicants respectively traverse the Section 102(e) and Section 103(a) rejections.

Applicants claim 1 is directed to a pair of medical electrodes which include the following elements:

- a first electrode including,
  - a first electrically conductive coating of a first metal and a first amount of metal chloride, and
- a second electrode including,
  - a second electrically conductive coating of a second metal and a second amount of metal chloride, **the second amount of metal chloride being greater than the first amount of metal chloride.**

It is Applicants contention that the pair of metal electrodes defined by claim 1 are patentably distinguished from the Katzenmaier Patent at least based on the requirement that the second amount of metal chloride in the second electrode is greater than the first amount of metal chloride in the first electrode (hereinafter generally referred to as the "Metal Chloride Feature" of Applicants' claimed invention). Simply put, the Metal Chloride Feature is not taught or suggested in the Katzenmaier Patent, or the Ferrari Patent, or the Gadsby Patent.

As Applicants explain throughout the pending application, a problem with conventional medical electrodes is that polarization can result if, for example, the metal chloride is depleted in the negative electrode. See for example page 11 of the

pending application. To overcome this problem, Applicants proposed the novel feature of requiring that the second amount of metal chloride in the second electrode be greater than the first amount of metal chloride in the first electrode (i.e., the Metal Chloride Feature). This problem is not considered or even remotely recognized in the Katzenmaier, Ferrari, or Gadsby Patents.

Applicants' independent claim 2 is directed to a pair of medical electrodes including the following elements:

- a first electrode including,
  - a first electrically conductive gel pad including a first buffer, and
- a second electrode including,
  - a first electrically conductive gel pad including **a second buffer.**

It is Applicants contention that the pair of medical electrodes defined by claim 1 are patentably distinguished from the Katzenmaier, Ferrari, and Gadsby Patents at least based on the requirement that the first electrically conductive gel pad includes a first buffer and the second electrically conductive gel pad includes a second buffer (hereinafter generally referred to as the "Buffer Feature" of Applicants' claimed invention). In other words, the Buffer Feature is not taught or suggested in the references of record.

As Applicants state in their pending application, there is a further problem resulting from polarization and that is that a patient's skin can be burned. Applicants overcome this problem, which is not acknowledged by the references of record, by adding first and second buffers.

The Office Action looks to the Katzenmaier Patent as the primary reference in basing its rejection of Applicants' claimed invention. In rejecting Applicants' claimed invention, the Office Action cites the following broad and sweeping statements made in the Katzenmaier Patent:

With such specificity, electrodes 50 and 52 can be optimized to provide the best possible conductor layers for negative polarity and positive polarity, respectively. Optimization of electrodes 50 and 52 could be arranged in terms of **ratio of silver to silver chloride**, pH, **buffers**, salts, and the like to optimize one electrode as to cathode for negative polarity and an anode for positive polarity.

See Column 13, lines 31-38 of the Katzenmaier Patent. (Emphasis added). But this broad and sweeping statement made by the Katzenmaier Patent does not teach or suggest the Metal Chloride Feature or the Buffer Feature of Applicants' claimed invention. To reach such conclusion is nothing more than "hindsight reconstruction" of Applicants' claimed invention. In other words, the Office Action is reading Applicants' invention into this statement of Katzenmaier based on Applicants' disclosure. It is Applicants' position that one skilled in the art would not consider the Metal Chloride Feature or the Buffer Feature unless one had read the subject application. The Katzenmaier Patent simply does not focus on or consider the problems which Applicants have overcome by means of the Metal Chloride Feature and Buffer Feature.

One skilled in the art reading the above quoted statement from Katzenmaier could easily, and probably, consider that this "optimization" statement means nothing more than the conventional silver to silver chloride ratio of 10% to 90% in both the positive and negative electrodes. Prior to Applicants' claimed invention, that is the ratio that one skilled in the art would use. And as regards the use of a buffer, one skilled in the art reading the "optimization" statement in the Katzenmaier Patent would assume that they were referring to the use of the same buffer for both electrodes. Applicants also submit that there is no teaching or suggestion in the Katzenmaier Patent as to where the buffers would be used. That is to say, it does

not disclose using the buffers in the conductive gel pad as defined in Applicants' claimed invention.

Based on the foregoing, Applicants respectively submit that the Katzenmaier Patent does not teach the Metal Chloride Feature or the Buffer Feature of Applicants' claimed invention and therefore it is improper to base a Section 102 or Section 103 rejection on the Katzenmaier Patent as set forth in the Office Action.

With respect to the Metal Chloride Feature and Buffer Feature, the Office Action readily admits that these features are not taught in the Ferrari Patent at page 4 of the Office Action and relies on the Katzenmaier Patent. And as noted above, the Katzenmaier Patent is defective in its teaching of these features of Applicants' claimed invention.

As for the Gadsby Patent, it is Applicants' position that this patent is not prior art. The Gadsby Patent issued on July 29, 2003, but the subject application was filed on October 17, 2001. Thus at best the Gadsby Patent is a Section 102(e) reference. But the Gadsby Patent can not be a Section 102(e) reference because it includes the same inventor as found in the subject application, and the Gadsby Patent on its face is assigned to the same assignee as the subject application, the Ludlow Company LP of Chicopee, MA. Thus, as the Office Action itself points out, an application filed after November 29, 1999 is not a proper reference if the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP Section 706.02(I)(1) and Section 706.02(I)(2). It is obvious on the face of the Gadsby Patent and from the assignment documents filed with the subject application that they were both owned by the Ludlow Company at the time of Applicants' claimed invention. Applicants therefore request that the Gadsby Patent be withdrawn as a reference.

Applicants further contend that independent claims 3 and 16 also include one or both of the Metal Chloride Feature and Buffer Feature of Applicants' claimed invention, and therefore these claims and the claims dependent thereon are likewise patentably differentiated from the references of record for the reasons noted above.

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In view of the foregoing remarks, Applicants request that the Section 102 and Section 103 rejections be withdrawn.

It is Applicants contention that all pending claims are in condition for allowance. Reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,



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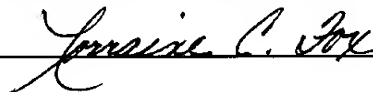
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